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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,546	06/05/2003	Ernst Kraenzler	1969	7609
7590	02/01/2007		EXAMINER	
Michael J Striker Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			CHUKWURAH, NATHANIEL C	
			ART UNIT	PAPER NUMBER
			3721	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	02/01/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/049,546	KRAENZLER ET AL.
	Examiner	Art Unit
	Nathaniel C. Chukwurah	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 November 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16-28 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 18 is/are allowed.
- 6) Claim(s) 16,17,19-28 and 33-39 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 February 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This office action is in response to the amendment filed on 11/9/2006.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In claim 36, the word "means" is preceded by the word(s) "for" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16- 17, 19-20, 22-26, 28 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forderer et al. (US 5,699,865) in view of Dorner et al. (US 5,46,566).

With regard to claim 16, Forderer et al. et al. discloses a power tool with at least one handle (19) which comprises at least one grip part (19) firmly connected to and held at a mounting part (35 , 45) by at least one elastic, vibration-damping element (22) between the grip part (19) and the mounting part (35, 45), and the grip part affixable to a housing (2), via the mounting part (35 , 45), and the connection between the grip part (19) and the mounting part (35, 45) by means of the elastic element is secured by at least one movable retaining element (50). See (col. 5, line 29).

The elastic element does not require the condition of preventing the separation of the grip part from the housing if damaged, to meet the limitation.

The reference of Forderer et al. discloses all claimed subject matter but lacks specific teaching of the retaining element firmly connected to a fastening screw located in mounting part.

However, the power tool of Dorner et al. teaches a retaining element (50, 60) firmly connected to a fastening screw (55) located in mounting part (41) for holding the elastic element fixedly to the motor.

In view of the teaching of Dormer et al., it would have been obvious to one skilled in the art at the time of the invention to provide the power tool Forderer et al. with a fastening screw in order to hold the elastic element fixedly to the motor and to prevent transferring vibrations from the motor to the handle unit.

With regard to claim 17, Forderer et al. does not expressly state that the retaining element is flexible. The retaining element (50) is inherently flexible to a degree.

With regard to claim 19, the retaining element (50) is located in the elastic element (22) along a center line (see Fig. 2).

With regard to claim 20, retaining element (50) is capable of being subjected to tensile stresses and the elastic element (22) is capable of being subjected to compressive stresses.

With regard to claims 22 and 23, the retaining element (50) is formed by a rigid component that is rigidly supported and capable of moving relative to the mounting part (45) and grip part (19).

With regard to claims 24 and 25, the power tool of Forderer et al. discloses all claimed subject matter but lacks specific teaching of the retaining element firmly connected to a fastening screw located in mounting part.

However, the power tool of Dorner et al. teaches a retaining element (50, 60) firmly connected to a fastening screw (55) located in mounting part (41) for holding the elastic element fixedly to the motor.

In view of the teaching of Dorner et al., it would have been obvious to one skilled in the art at the time of the invention to provide the power tool Forderer et al. with a fastening screw in order to hold the elastic element fixedly to the motor and to prevent transferring vibrations from the motor to the handle unit.

With regard to claim 26, the power tool of Forderer et al. includes the retaining element (45) being connected the to grip part (19) via the elastic element (22) and to the mounting part (35) via the elastic element (22).

With regard to claim 28, the power tool of Forderer et al. includes elastic element comprising non-circular cross- section area at least closely before the seating surface (36) of the elastic element (22) for the mounting part (35) and grip part (19) wherein the cross- sectional area is smaller than the seating surface (Fig. 2).

With regard to claim 33, the power tool of Forderer et al. includes a retaining element (50) enclosed by the elastic element (22).

With regard to claim 34, the grip part (9) of the power tool of Forderer et al. comprises a recess (90), in which the retaining element is located.

With regard to claim 35, the recess (90) of the power tool of Forderer et al. is partially filled with the elastic element (22).

With regard to claim 36, means for retaining the grip part is deemed connected to the mounting part in captive fashion.

With regard to claim 37, the modified retaining element of Forderer et al. includes a screw (55) having a screw head which is larger than the recess as shown in Figure 2 of Dorner et al.

With regard to claim 38, the power tool of Forderer et al. includes the elastic element having a flange gripping behind an edge region of the recess (see flanged section of elastic element around edge region of recess (90)).

With regard to claim 39, the modified retaining element of Forderer et al. includes the elastic element (Dorner et al. 30, 60) has a flange (Dorner et al. Fig.2) preventing a direct contact between the screw head and the grip part (Dorner et al. 6).

7. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forderer et al. in view of Raddle et al. (US 5,697,456).

With regard to claim 21, the power tool of Forderer et al. discloses all claimed subject matter but lacks specific teaching of the retaining element formed by a band which encloses the elastic element.

The power of Radle et al. teaches a retaining element (100) formed by a band which encloses the elastic element (96, 98) for protective covering.

In view of the teaching of Radle et al., it would have been obvious to one skilled in the art at the time of the invention to incorporate into the power tool Forderer et al. with the retaining element formed by a band enclosing the elastic element for protective covering.

With regard to claim 27, the displacement of the elastic element (22) is determined by the retaining element (50) in tilting direction.

Response to Arguments

8. Applicant's arguments filed 11/9/2006 have been fully considered but they are not persuasive.

Applicant argues that Forderer et al.'s vibration-damping element is mounted directly on the housing 2 and not via a mounting part as defined in claim 16.

The examiner contends that Forderer et al.'s vibration-damping element is mounted on the housing 2 via a mounting part (35, 38).

Further, Forderer et al.'s vibration-damping element does not require the condition of "preventing a loosening of the grip part from the housing in the event of a damage to the elastic element" to meet the claim limitation.

Applicant argues that the patent to Dorner discloses no securing element, for securing the bearing connection.

The examiner used the reference of Dorner et al. to teach the screw securement.

Applicant argues that neither Forderer et al. nor Dorner et al. provide any suggestion for the feature of securing a retaining element in the sense of the applicant's invention.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references combined disclose and teach the claim limitation, for

example, mounting part, screw securement, retaining element and vibration elastic element. Therefore, the rejection is proper.

Allowable Subject Matter

9. Claim 18 is allowed over prior art of record.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose a retaining element formed by a rope.

Response to Arguments

10. Applicant's arguments filed 11/9/2007 have been fully considered but they are not persuasive.

With respect to claim 16, applicant argues that none of the references eaches the new feature of the amended claim 16.

The examiner contends that the combination of Forderer et al. and Dorner et al. disclose the invention of the amended claim 16 as shown above in the new rejection necessitated by the amendment.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

January 30, 2007.



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700

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